RESPONSE AND REMARKS

Claim Objections Under Section 112

The Office Action objected to Claim 25 under 35 U.S.C. §112, second paragraph, asserting that the claim is indefinite for failing to point out and distinctly claim the subject matter regarded as the invention. *Office Action*, Topic No. 15, p. 10. In particular, the Office Action stated that Claim 25 "contains an action that is to be performed if a particular condition is present ...[but] ... does not also state what action occurs if that particular condition is not present." *Id.* The Section 112 objections refer to the claimed limitation "... for a first combination that would not trackably identify the particular first class mail piece during the particular period of time....." *Id.* The Section 112 objections also refer to the claimed limitation "... if the maximum mailing identifier is exceeded before the combination would trackably identify the particular first class mail piece during a particular period of time ...." *Id.*

The objections have been carefully considered.

With regard to the Section 112 objections that refer to the claimed limitation "... for a first combination ...", it is respectfully asserted that Claim 25 is dependent on Claim 1. Claim 25 recites details comprising the modifying process claimed in Claim 1. In Claim 1, the modifying process recites:

> modifying at least one of the next available mailing tracking subscriber identifier and the next available mailing identifier, until determining a combination ... that would trackably identify the particular first class mail piece during a particular period of time in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings ....

It is respectfully submitted that because the modifying process recited in Claim 1 describes that the modifying process is performed "... until determining a combination ... that would trackably identify the particular first class mail piece during a particular period of time ...", the high-level modifying process recited in Claim 1 therefore indicates the action that would occur when the particular

condition in the objected to limitation in Claim 25 is not present; dependent Claim 25 is therefore definite.

With regard to the Section 112 objections that refer to the claimed limitation "... if the maximum mailing identifier is exceeded before the combination would trackably identify ... ", it is respectfully submitted that the objected to limitation is subject to the higher level incrementing process of Claim 25 that recites:

> incrementing the next available mailing identifier until a maximum mailing identifier is exceeded or until the combination of the destination tracking service type, the next available mailing tracking subscriber identifier, the next available mailing identifier, and the delivery address identifier, would trackably identify the particular first class mail piece during a particular period of time, whichever occurs first;

It is respectfully submitted that the higher level incrementing process of Claim 25 indicates the action that would be taken if the maximum mailing identifier is not exceeded, namely, until the condition is reached that the "combination ... would trackably identify ...." Because the objected to limitation of Claim 25 is subject to the higher level process that defines the action that would be taken if the condition in the objected to limitation of Claim 25 is not present, it is therefore respectfully submitted that Claim 25 is definite.

Claim Rejections Under 35 U.S.C. 101

The Office Action rejected Claims 1, 5-6, 8-9, 13-15, and 23-25 under 35 U.S.C. § 101, asserting that "the claimed invention is directed to non-statutory subject matter ...." *Office Action*, Topic No. 16, p. 11.

The rejections under Section 101 have been carefully considered. For the following reasons and under the following authorities, it is respectfully asserted that Claims 1, 5-6, 8-9, 13-15, and 23-25, as amended, are directed to statutory subject matter under Section 101.

Amended independent Claim 8 recites "... [a] computer program product, comprising a computer-readable medium having a computer-readable program code embodied therein, said computer-readable program code adapted to be

executed to implement a method for printably rendering a trackable mail piece identifier graphic symbology ...." It is respectfully asserted that a "computer program product, comprising a computer-readable medium having a computer-readable program code embodied therein ..." as claimed by amended Claim 8 is directed to patentable subject matter under Section 101. *See, e.g.*, MPEP § 2106.01, I.

It is respectfully asserted that amended independent Claims 1 and 23 are tied to a particular machine or apparatus and therefore comprise patent subject matter in view of *In re Bilski*. In particular, according to the Court of Appeals for the Federal Circuit in the case *In re Bilski*, a process is patentable if: "(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (*en banc*).

It is respectfully asserted that amended Claim 1 is tied to a particular machine. In particular, amended independent Claim 1 recites:

> A computer-implemented method ... said method implemented using a computer-based postage system programmed for operation on behalf of the first class mail piece tracking provider, said computer-based postage system available for communication with each respective customer of the plurality of customers ...

It is respectfully asserted that amended independent Claim 23 is also tied to a particular machine or apparatus, in that it recites a "computer-based postage system" and also recites "... reporting to a display device in communication with a client computer ...."

It is therefore respectfully asserted that amended independent Claims 1 and 23, and their dependent Claims 2-7 and 25, are directed to patentable subject matter. *See In re Bilski*, 545 F.3d at 954.

It is respectfully asserted that amended independent Claims 10, 13, 18 and 24 recite transformations of data into a different state. For example, amended Claim 10 recites "...encoding the tracking identifier as a machine-readable graphic symbology ..." It is respectfully asserted that amended independent Claims 13, 18 and 24 recite similar transformations of data into a

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different state. Accordingly, it is respectfully asserted that amended independent Claims 10, 13, 18 and 24, and their dependent Claims 12, 15-17, 21-22, 24 and 26, are therefore directed to patentable subject matter. *See In re Bilski*, 545 F.3d at 954.

Claim Rejections Under 35 U.S.C. 102 (e)

The Office Action rejected Claims 10-12 and 18 under 35 U.S.C. § 102(e) as being anticipated by Montgomery, et al. (U.S. Application Publication No. 2003/0101143 A1; "*Montgomery*"). *Office Action*, Topic No. 17, pgs.11-15.

Claim Rejections Under 35 U.S.C. 103

The Office Action rejected Claims 1-3, 5, and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of Baker, et al., (U.S. Patent Application Publication No. US 2004/0215478 A1, "*Baker*"), and further in view of Watson, Neva, "Changes to the Domestic Mail Manual to Implement Confirm (R) – Service" ("*Watson*") *Office Action*, Topic No. 18, pages 15-25.

The Office Action rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of *Baker*, in further view of *USPS CONFIRM® Changes*, and in further view of Leon (U.S. Patent No. 7,069,253; "*Leon*"). Office Action, Topic No. 19, pgs. 25-26.

The Office Action rejected Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of *Baker* in further view of *Watson*, and in further view of Denman (U.S. Patent No. 5,737,729; "*Denman*"). *Office Action*, Topic No. 20, p.27.

The Office Action rejected Claims 13-17 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of *Baker*. *Office Action*, Topic No. 21, pgs. 27-30.

The Office Action rejected Claims 21-22 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery*. *Office Action*, Topic No. 22, pgs. 30-31.

The Office Action rejected Claim 23 under 35 U.S.C. § 103(a) as being unpatentable over _Montgomery_ in view of _Leon_. _Office Action_, Topic No. 23, pgs. 31-33.

The Office Action rejected Claim 24 under 35 U.S.C. § 103(a) as being unpatentable over _Baker_. _Office Action_, Topic No. 24, pgs. 33-34.

The Office Action also provided a detailed explanation of the reasoning underlying the rejections. _See_ _Office Action_, Topic Nos. 7-14, pgs. 2-9.

RESPONSIVE REMARKS REGARDING SECTION 102(e) and Section 103(a) REJECTIONS

The rejections of the Claims of the present application under Sections 102(e) and 103(a) have been carefully considered. Claims 1-10, 12-13, 15-18, and 21-25 have been amended to more distinctly claim the claimed invention; Claims 11 and 14 have been cancelled; Claims 19-20 have were previously cancelled; new dependent Claim 26 has been added.

In addition to the reasons previously given, for the reasons given, and under the authorities cited below, it is respectfully asserted that none of the references of record, even when considered in combination, disclose, anticipate, teach or suggest all of the limitations of the amended Claims of the present application.

Amended Claim 1 is directed to:

> A computer-implemented method for a first class mail piece tracking provider to provide, to a plurality of customers of the first class mail piece tracking provider, tracking of individual outbound first class mail pieces respectively initiated in a mail stream by respective customers of the plurality of customer, said method implemented using a computer-based postage system programmed for operation on behalf of the first class mail piece tracking provider, said computer-based postage system available for communication with each respective customer of the plurality of customers ...

Amended Claim 10, for example, similarly claims that a user is a customer user of a computer-based postage provider that has been authorized by a postal authority to create machine- readable first class mailing tracking graphic symbologies in accordance with the authorization by the postal authority.

The Office Action cites _Montgomery_ as disclosing a "middleman configuration" that is "under control of the postal service" (_Office Action_, Topic No. 9, pgs. 3-5) and asserts that "… Montgomery … discloses an option where new tracking numbers are generated …" (_Office Action_, Topic No. 10, p. 6). The Office Action asserts that these asserted features of _Montgomery_ are equivalent to limitations of the Claims of the present application. _See, e.g., Office Action_, Topic No. 17, p. 12.

The Office Action asserts interpretations of a number of claimed limitations. For example, the Office Action interprets the mail piece tracking identifier of the Claims of the present application as equivalent to the tracking number of _Montgomery_. _See, e.g., Office Action_, Topic No. 17, p. 12; _Office Action_, Topic No. 18, pgs. 15-16. Further, the Office Action interprets the mailing subscriber identifier of the Claims of the present application as equivalent to the vendor ID of _Montgomery_. _See, e.g., Office Action_, Topic No. 17, p. 12; _Office Action_, Topic No. 18, pgs. 15-16.

For reasons given further below, Applicants respectfully disagree with the interpretations by the Office Action of these and other claimed terms. Even so, it is respectfully asserted that claim amendments made herewith more distinctly claim the claimed invention that is distinguished from the cited references.

It is respectfully submitted that _Montgomery_ discloses a computer-based postage system provider that provides digitally signed postage indicia to its customers. _See, e.g., Montgomery_, ¶ [0035]; _Montgomery_, ¶ [0043]; _Montgomery_, ¶ [0184]. It is respectfully submitted that, except for types of mail for which a tracking identifier already exists, _Montgomery_ discloses generating a self-styled character string named a Tracking Number, and discloses that the _Montgomery_ computer-based postage system provider incorporates the self-styled tracking number in digitally signed postage indicia. _See, e.g., Montgomery_, ¶ [0103], Table 2; _Montgomery_, ¶ [0043] ("… generating … a self-validating unique postage indicum … [that] contains a character string (such as, e.g., a tracking ID) unique to the postal system and a digital signature that is derived from the tracking ID ….").

It is respectfully asserted that providing tracking of first class mail pieces "... in accordance with [an] authorization by [a] postal authority to the first class mail piece tracking provider for tracking first class mailings ..." as claimed, for example, by amended Claim 1, and creating machine-readable first class mailing tracking graphic symbologies in accordance with an authorization by a postal authority as claimed by amended Claim 10, are patentably distinct from, and. useful over, the computer-based postage system provider of _Montgomery_ that provides digitally signed postage indicia to its customers which incorporates a self-styled tracking number.

In particular, it is respectfully asserted that, as claimed by the Claims of the present application, and as explained in the Specification, mailing tracking barcodes that are generated by mailing tracking subscribers in accordance with an authorization by the postal service for mailing tracking, will be scanned by the postal service; the scan events will be provided, with associated mailing tracking information, to the relevant mailing tracking subscribers. _See, e.g., Specification_, p. 6, lines 20-24; _Specification_, p. 17, line 29 – p. 18, line 14. See also, e.g., _Publication 197_, Section 1.

Further, as compared to the amended claimed limitations, such as claimed by amended Claim 1, for assigning mail piece tracking identifiers "... in accordance with [an] authorization by [a] postal authority to the first class mail piece tracking provider for tracking first class mailings ...," it is respectfully asserted that by incorporating a self-styled tracking number in digitally signed postage indicium (_see, e.g., Montgomery_, ¶ [0103], Table 2), _Montgomery_ then relies on the postal service to scan the digitally signed postage indicium to detect fraud (_see e.g., Montgomery_, ¶ [0137]), in order to obtain tracking information.

Montgomery admits that such reliance would only provide scanning of a small percentage of mail pieces bearing _Montgomery_ "tracking numbers." _See e.g., Montgomery_, ¶ [0137]. _Montgomery_ projects that the postal service may someday scan "100% of the postage indicia" (_Montgomery_, ¶ [0137]; cited by the _Office Action_, Topic No. 11, p. 6), but concedes that until then, "... the USPS only spot checks the postage indicia ...." (_Montgomery_, ¶ [0137]).

It is respectfully asserted that the above-mentioned concession by _Montgomery_ is evidence that the claimed limitations of the Claims of the present application for assigning mail piece tracking identifiers "... in accordance with [an] authorization by [a] postal authority to the first class mail piece tracking provider for tracking first class mailings ...," so that tracking scanning events will be provided by the postal service in accordance with the authorization by the postal service, is distinguished from _Montgomery_.

Yet further, the Office Action indicates that the claimed mailing subscriber identifier is properly interpreted to be equivalent to the vendor ID in _Montgomery_. See _Office Action_, Topic No. 13, p. 8.

The grounds for the interpretation have been carefully considered. For the reasons previously given, and which are incorporated by reference herein, Applicants respectfully disagree with the interpretation in the Office Action. Even so, the Claims have been amended to more distinctly claim the claimed invention. As amended, Claim 1, for example, claims:

> ... the plurality of mailing tracking subscriber identifiers corresponding to an authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings ....

See also, e.g., amended Claims 8, 10, 13, 18, 23 and 24.

It is respectfully asserted that the amended claimed limitations for a mailing tracking subscriber identifier, or a mailing subscriber identifier, are distinguished from a vendor ID as described in _Montgomery_ because _Montgomery's_ vendor ID does not comprise an authorization by the postal authority for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority.

Accordingly, for the reasons given and authorities cited above, it is respectfully asserted that _Montgomery_, even when considered in combination with the other cited references, fails to disclose, for example, the combination of limitations claimed by the Claims of the present application as amended.

Therefore, for the above-given reasons, it is therefore respectfully asserted that the Claims of the present application, as amended, are distinguishable from, and patentable over, _Montgomery_, even when that reference is considered in combination with the other cited references.

Yet further, as compared to incorporating a tracking number in a digitally signed postage indicium and then relying on the postal service to scan the digitally signed postage indicia as disclosed in _Montgomery_, it is respectfully asserted that amended Claim 7, for example, claims:

> encoding the first class mail piece tracking identifier as a machine-readable bar code; and
> formatting the machine-readable bar code for print rendering as a label for the particular first class mail piece.

See also, e.g., Claims 15, 16/17, and 21/22.

It is respectfully asserted that the formatting claimed in Claim 7 (and see, e.g., Claims 15, 16/17 and 21/22) of a machine-readable graphic symbology/bar code of a first class mail piece identifier that is generated "... in accordance with [an] authorization by [a] postal authority to the first class mail piece tracking provider for tracking first class mailings ..." for printing, is distinguished from a tracking number that is incorporated in the fields of a digitally signed postage indicium as disclosed in _Montgomery_. In particular, as compared to the character string called a tracking ID that is incorporated in digitally signed postage indicia in _Montgomery_ that is only spot-checked to detect fraud, as further explained in the Specification of the present application:

> As each mail piece progresses through to its destination, the CONFIRM® barcode on each mail piece is scanned at the different USPS processing facilities through which it passes. Electronic information for each scan is captured and is sent to a centralized network service, which collects the scan data and packages it for use by USPS customers. The electronic scan information is then electronically transferred from the centralized network and is made available in two ways: through accessing a PLANET™ Codes website or via transmission of electronic files sent to subscribing USPS customers.

Specification, p. 2, lines 18-25.

For the above-given reasons, it is therefore respectfully asserted that Claims 7, 15, 16/17, and 21/22, and the Claims that are dependent on them, are therefore patentable.

The Office Action asserts a combination of _Baker_ with _Montgomery_ as grounds for rejecting Claims 1-3, 5 and 7-9. In particular, the Office Action states that _Montgomery_ fails to disclose that a tracking identifier includes a destination tracking service type, but asserts that _Baker_ does. See _Office Action_, Topic No. 18, p. 18. Further, the Office Action asserts that there is motivation to combine _Baker_ with _Montgomery_, asserting that "[m]otivation is provided by Baker ... in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired ...." _Office Action_, Topic No. 18, p. 18.

However, it is respectfully asserted that there is no teaching or suggestion as required under MPEP §706.02(j), to combine _Baker_ with _Montgomery_ to show obviousness of the Claims of the present application, in that _Montgomery_ is not directed to, and does not disclose, any mailing tracking service, such as CONFIRM®, or any relationship to such a service that is authorized by the postal service.

Further, in view of reasons explained further below, it is respectfully asserted that the combinations asserted by the Office Action of _Watson_ with _Montgomery_, _Baker_ with _Montgomery_, _Leon_ with _Montgomery_, and _Denman_ with _Montgomery_, are guided by an improper hindsight perspective gleaned from the present application. Cf. _In re Mahurkar Patent Litigation_, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), aff'd, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden _ex post_ analysis. ... (Citations omitted) ... With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. 'Virtually all inventions are combinations and virtually all are combinations of old elements.' ... (Citations omitted) ... .Citations omitted).").

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Yet further, as distinguished from _Baker_, it is respectfully asserted that the amended Claims of the present application claim limitations regarding a plurality of customers of a provider that has been authorized by a postal authority for tracking first class mailings. For example, amended independent Claim 1 claims, among other things:

> ... recording a plurality of mailing tracking subscriber identifiers assigned by a postal authority to the first class mail piece tracking provider, the plurality of mailing tracking subscriber identifiers corresponding to an authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings ....

Amended independent Claim 1 further claims:

> ... modifying at least one of the next available mailing tracking subscriber identifier and the next available mailing identifier, until determining a combination of a destination tracking service type, the next available mailing tracking subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, ... that would trackably identify the particular first class mail piece during a particular period of time ....

Amended independent Claim 1 further claims:

> ... assigning the first class mail piece tracking identifier to the particular first class mail piece, wherein the first class mail piece tracking identifier trackably identifies the particular first class mail piece during the particular period of time ....

The Office Action asserts that _Baker_ discloses a system with multiple end users (_Office Action_, Topic No. 9, p. 5 (citing paragraph [0028] of _Baker_ and stating that _Baker_ discloses "plural 'mailers'").

Applicants respectfully disagree that the cited paragraph [0028] of _Baker_ discloses multiple end users of _Baker_. Rather, paragraph [0028] of _Baker_ cited by the Office Action indicates that the United States Postal Service assigns "... unique (and fixed) 5-digit ID ... to identify mailers subscribed to the PLANET code service offering." _Baker_, ¶ [0028]. It is respectfully asserted that, therefore,

the cited paragraph [0028] of _Baker_ merely discloses multiple "mailer" subscribers of the USPS.

As compared to the above-recited limitations of amended Claim 1 regarding a plurality of customers, for example, it is respectfully asserted that _Baker_ asserts disclosure of a method for generating a unique tracking number based on PLANET™ and POSTNET codes based on only a _single PLANET™ subscriber ID_ for a _single CONFIRM® subscriber._ See, e.g., _Baker,_ [0008] ("Specifically, of these 9 or 11 digits, the first five digits is a unique (and _fixed_) 5-digit ID assigned by the United States Postal Service to identify mailers subscribed to the PLANET code service offering." (Emphasis added)); _see also, e.g., Baker,_ [0028].

The Office Action further asserts that _Watson_ discloses multiple subscriber identifiers being assigned to a single subscriber. _See, e.g., Office Action,_ Topic No. 8, p. 3; _see also, e.g., Office Action,_ Topic No. 18, p. 23. The Office Action also asserts that "Applicants ... argue that the prior art references do not disclose serving a user from among a plurality of users ..." (_Office Action,_ Topic No. 9, p. 3) and asserts that _Montgomery_ discloses a "middleman configuration" that is "under control of the postal service" (_Office Action,_ Topic No. 9, pgs. 3-4).

It is respectfully asserted that there is no teaching or suggestion as required under MPEP §706.02(j), to combine _Watson_ with _Montgomery_ to show obviousness of the Claims of the present application, in that _Montgomery_ is not directed to, and does not disclose, any mailing tracking service, such as CONFIRM®, or any relationship to such a service that is authorized by the postal service.

Further, Applicants respectfully clarify that, as explained further below, the cited references do not disclose, anticipate, teach or suggest a method for tracking mail pieces mailed by a plurality of customers of a single mailing tracking subscriber of a mailing tracking service such as CONFIRM®, as would be provided by various embodiments of the amended Claims of the present application. Moreover, it is respectfully asserted that such various exemplary embodiments would be useful over the cited references. Accordingly, it is

respectfully asserted that the Claims of the present application are therefore patentable.

It is respectfully submitted that _Watson_ discloses, as does the Specification of the present application and _Publication 197_, incorporated in the Specification by reference (_See Specification_, p. 1, lines 26-29), the assignment of multiple subscriber identifiers to a single mailing tracking subscriber. Similar to _Watson_, the Specification of the present application explains that "[a]s a CONFIRM® Service subscriber, the exemplary mail piece tracking provider registers with the U.S. Postal Service to obtain one or more subscriber identifiers (subscriber IDs). ... three (3) exemplary subscriber IDs will be described herein ...." _Specification_, p. 10, lines 19-23. The Specification of the present application also incorporates by reference _Publication 197_ (_see Specification_, p. 1, lines 26-29); like the Specification, _Publication 197_ also describes assigning multiple subscriber IDs to a single subscriber. _See, e.g., Publication 197_ , Section 2 ("Subscribing to Confirm"; a courtesy copy of Sections 1 and 2 of a recent version of _Publication 197_ are attached hereto under "Attachment A").

Even though the assignment of multiple subscriber identifiers is explained in the Specification and in _Publication 197_, it is respectfully asserted that neither _Publication 197_ nor the disclosure of _Watson_ disclose "modifying at least one of the next available mailing tracking subscriber identifier and the next available mailing identifier, until determining a combination ... to comprise a first class mail piece tracking identifier that would trackably identify the particular first class mail piece during a particular period of time ..." as claimed, for example, by Claim 1. In particular, it is respectfully asserted that none of the cited references, including _Publication 197_, _Watson_, _Baker_ or _Montgomery_, disclose, anticipate, teach or suggest a single subscriber to a mailing tracking service providing mail piece tracking to a plurality of customers of the subscriber.

In particular, it is respectfully asserted that a mailing tracking service, such as the CONFIRM® service, was provided for USPS subscribers to be able to track their "_mailings_", _not_ particular mail pieces. _See, e.g., Specification_, p. 3, lines 13-18 ("... the CONFIRM® Service does not guarantee tracking of

individual mail pieces."). As explained in the Specification, the CONFIRM® Service as provided by the USPS would not provide mail piece tracking in circumstances where, for example, a single mailing included more than one mail piece that is addressed to a single delivery address. *See, e.g., Specification*, p. 2, line 30 – p. 3, line 2 ("A POSTNET Code identifies a particular delivery address. A PLANET™ Code identifies a particular CONFIRM® Subscriber's mailing. If more than one mail piece in a single mailing is addressed to the same delivery address, then the CONFIRM® Service does not provide individual mail piece tracking.").

Even when a single subscriber is tracking its own mailings, it is respectfully asserted that circumstances can arise where multiple mail pieces are addressed to the same delivery address. For example, a single subscriber might mail letters, or other mail matter, to different individuals at the same address. Or, a single subscriber might want to mail different types of mail matter to the same individual at a single address. In such circumstances, it is respectfully asserted that the CONFIRM® Service as described by *Watson*, without more, would not provide first class mail piece tracking for the single subscriber.

Further, as compared to a single subscriber tracking its own mailings, where, as for various embodiments of the Claims of the present application, a single mailing tracking subscriber is providing the CONFIRM® Service to multiple customers, the likelihood of multiple mail pieces going to the same address is increased. As an illustrative example, during tax filing/payment cycles, it is respectfully asserted that it would be likely that more than one customer of a single mailing tracking subscriber that is providing the CONFIRM® Service to a plurality of its customers would send a mail piece to the same tax entity on the same day. In such a situation, it is respectfully asserted that the CONFIRM® Service as described by *Watson*, without more, would not provide first class mail piece tracking.

As compared to *Baker*, which, as previously mentioned above, only discloses tracking for a single subscriber ID, and as compared to *Watson* that, for the reasons given above, discloses tracking mailings of a single subscriber, even

for which there has been assigned multiple subscriber IDs, it is respectfully asserted that various exemplary embodiments of the amended Claims of the present application would be useful over the cited references, even when considered in combination, because such exemplary embodiments would provide customers of an authorized mailing tracking subscriber with a way to obtain tracking information for the customer's particular first class mail piece.

It is respectfully asserted that an authorized mailing tracking subscriber providing mail piece tracking information to its customers is useful over the cited references, including _Watson_ and _Baker_, because doing so would serve low volume mailers who are not subscribers of the mailing tracking service. _See, e.g., Specification_, p. 3, lines 3-4 ("The CONFIRM® service was designed to serve the high-volume mailer such as telemarketers and other businesses."); _Specification_, p. 3, lines 13-18 ("Although large mailings are not normally the concern of individuals, individuals with low volume mailings could benefit from the ability to track processing and delivery of individual mail pieces. Low volume mailers will not be motivated to pay the high subscription fees for the U.S. Postal CONFIRM® Service...."); _Specification_, p. 4, lines 2-6 ("The exemplary embodiment of the present invention provides a way for low-volume mailers to track individual outbound mail pieces, including tracking of individual U.S. Postal Service FIRST-CLASS MAIL® letters. The exemplary embodiment of the present invention supports tracking of multiple mail pieces mailed by multiple mailers using a single computer-based postage system.").

In rejecting Claim 4, which depends on Claim 1, the Office Action states that _Montgomery_, _Baker_ and _Watson_ fail to disclose a postal services vendor receiving a request from a particular user for tracking information regarding a particular first class mail piece and reporting the tracking information to the particular user. _See Office Action_, Topic No. 19, p. 25. However, to fill in the stated gap, the Office Action asserts that _Leon_ discloses these features and asserts combination of _Leon_ with _Montgomery_. _See Office Action_, Topic No. 19, pgs. 25-26.

In rejecting independent Claim 23, the Office Action states that _Montgomery_ fails to disclose a postage vendor reporting to a particular user, a set of tracking information associated with an electronic first class mail piece identifier representation, but asserts that _Leon_ does. _Office Action_, Topic No. 23, p. 32.

It is respectfully asserted that there is no teaching or suggestion as required under MPEP §706.02(j), to combine _Leon_ with _Montgomery_ to show obviousness of the Claims of the present application, in that neither _Leon_ nor _Montgomery_ is directed to, nor does either disclose, any mailing tracking service, such as CONFIRM®, or any relationship to such a service, authorized by the postal service. For example, it is respectfully asserted that the users in _Leon_ and _Montgomery_ would therefore not be customers of a provider that was authorized by a postal authority for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings, as claimed, for example, by amended Claim 1, on which rejected Claim 4 depends.

Rather, it is respectfully asserted that the combination asserted by the Office Action of _Leon_ with _Montgomery_ is guided by an improper hindsight perspective gleaned from the present application. _Cf. In re Mahurkar Patent Litigation_, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), _aff'd_, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Further, amended independent Claim 23 claims limitations regarding

> retrieving ... an electronic first class mail piece identifier representation ...[that matches an identifier that was] ... generated by [a] computer-based postage system according to an authorization by the governmental postal authority to a computer-based postage provider associated with the computer-based postage system, to create for customer users of the computer-based postage system, machine-readable, barcodes for tracking first class mail pieces; and
> reporting to a display device in communication with a client computer corresponding to the particular customer user, a set of tracking information associated with the electronic first class mail piece identifier representation.

It is respectfully asserted that the above-recited combination of limitations are not disclosed, anticipated, taught or suggested by _Leon_, even if considered in combination with _Montgomery_, because neither _Leon_ nor _Montgomery_ disclose reporting to a customer user, tracking information associated with an electronic first class mail piece identifier representation …[that matches an identifier that was] … generated by [a] computer-based postage system according to an authorization by the governmental postal authority to a computer-based postage provider.

In rejecting Claim 6, which ultimately depends on Claim 1, the Office Action states that _Montgomery_, _Baker_ and _Watson_ fail to disclose a delivery address identifier being obtained from Internet-based postage delivery address information. _See Office Action_, Topic No. 20, p. 27. However, to fill in the stated gap, the Office Action asserts that _Denman_ discloses this feature and asserts a combination of _Denman_ with _Montgomery_. _See Office Action_, Topic No. 20, p. 27.

It is respectfully asserted that there is no teaching or suggestion as required under MPEP §706.02(j), to combine _Denman_ with _Montgomery_ to show obviousness of the Claims of the present application, in that neither _Denman_ nor _Montgomery_ is directed to, nor does either disclose, any mailing tracking service, such as CONFIRM®, or any relationship to such a service, authorized by the postal service. In particular, it is respectfully asserted that the users in _Denman_ and _Montgomery_ would therefore not be a customer of a provider that was authorized by a postal authority for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings, as claimed, for example, by amended Claim 1 on which rejected Claim 6 ultimately depends.

Rather, it is respectfully asserted that the combination asserted by the Office Action of _Denman_ with _Montgomery_ is guided by an improper hindsight perspective gleaned from the present application. _Cf. In re Mahurkar Patent Litigation_, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D.
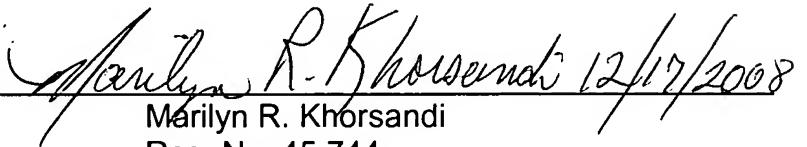
III. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

CONCLUSION

In view of the foregoing amendments, and for the foregoing reasons, it is respectfully asserted that the invention disclosed and claimed in the present application, as amended, is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application as amended herewith is respectfully requested.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By _____ 12/17/2008

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1 Confirm Service: A Summary

1-1   Service Description

Confirm® service allows mailers to uniquely identify and receive mail processing data for outgoing and incoming reply mailpieces. It provides mailers with information about automation-compatible letters and flats for First-Class Mail®, Standard Mail®, and Periodicals mail. Data includes:

a.   The date, time, and location that outgoing Confirm mail was inducted at a Postal Service facility.

b.   The date, time, location and sort operation at which a mailpiece was processed at a Postal Service facility.

Confirm requires that mailers display prescribed mail barcodes on the front of mailpieces. A mailer's proper application of these barcodes allows the Postal Service to generate Confirm scan data and distribute this data to the mailer.

Confirm provides two types of service: Destination Confirm and Origin Confirm.

1-1.1   Destination Confirm

Destination Confirm can provide mailers with an electronic notification when their outgoing mailpieces are inducted at a Postal Service facility and mailpiece processing data that helps them determine delivery.

1-1.2   Origin Confirm

Origin Confirm enables the Confirm mailer to determine when and where their customers mailed incoming reply mailpieces. Remittance mail processors and mail order companies use Origin Confirm to receive advance notice of incoming payments and orders.

1-1.3   Benefits

Mailers use Destination Confirm service to anticipate when their message will reach their customers, and they use Origin Confirm service to know when a response is on its way to them from their customers. Mailers can use Confirm service to align their business processes and resources with the actual processing and delivery status of their mail. Integrating Confirm data into current business practices puts valuable information in the hands of corporate decision makers, and that can help reduce costs, enhance marketing efforts, and improve their relationships with customers.

ATTACHMENT A

1-2   How Confirm Works: Process Overview

Confirm uses barcodes scanned by mail processing equipment to collect data from mailpieces as they are sorted and approach delivery.

Prior to using Confirm service, the mailer must become a Confirm subscriber. Refer to chapter 2 for steps required to subscribe to the service. Upon establishing a Confirm account, mailers follow the Confirm service process as noted below (see also Exhibit 1-2):

1.   Mail planning and preparation.

2.   Preshipment notification preparation and submission.

3.   Mail induction at a Postal Service facility.

4.   Mail processing at a Postal Service facility.

5.   Data access and interpretation.

Exhibit 1-2
Confirm Process Overview

Mail Planning
and Preparation

Preshipment Notification
and Submission

Mail Induction
at USPS

Data Access and Interpretation

Mail Processing at USPS
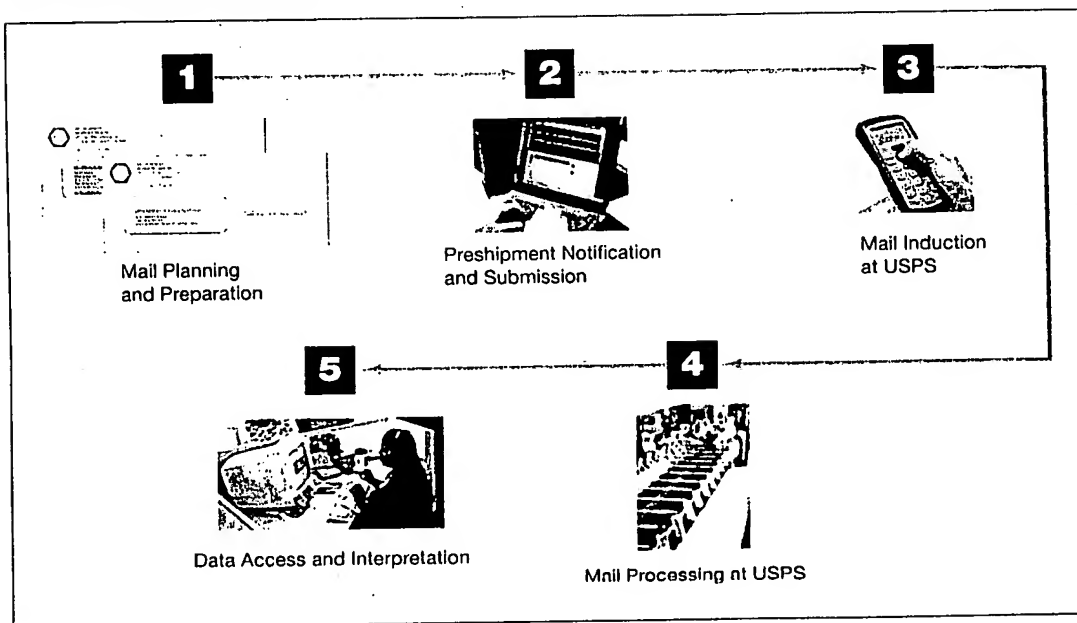
1-2.1   Mail Planning and Preparation

a.   The mailer decides whether to use Destination Confirm, Origin Confirm, or both.

b.   The mailer determines which prescribed Confirm barcodes to use to generate Confirm data, choosing from the following options:

(1)   PLANET Code® barcodes in combination with POSTNET™ (Postal Numeric Encoding Technique) barcodes.

(2)   OneCode Confirm™, which uses Intelligent Mail® barcodes. (For a discussion of the Intelligent Mail barcode — which is a "4-state" barcode — see 3-5.)

See chapter 3 for more information on barcoding options.

c. The mailer determines how many mailpieces to use to generate Confirm data, choosing from the following options:

(1) All mailpieces in the mailing.

(2) Only a sampling of the mailpieces (i.e., "seeding").

d. The mailer determines the information to include in the Confirm barcode. This includes the service type ID for the mailpieces.

e. The mailer ensures that mailpieces are designed and prepared in accordance with Confirm requirements and basic specifications for automation-compatible mail.

f. The mailer prepares mail to be inducted at a Postal Service facility.

Refer to chapter 3 for detailed information.

1-2.2 Preshipment Notification Preparation and Submission

a. For Destination Confirm mail only, the mailer prepares the preshipment notification (e.g., Electronic Mailing Data), validates the file, and submits it. The preshipment notification is an electronic manifest that describes where and when the mailer will drop the shipments/mailings into the mailstream, and the Confirm barcode(s) associated with each shipment. The preshipment notification provides information that the Postal Service requires to properly distribute entry scan data to the mailer and link those entry scans with associated mailpiece processing scan data.

b. If mailing or shipment information changes, the mailer updates the preshipment notification.

Refer to chapter 4 for detailed information.

1-2.3 Mail Induction at a Postal Service Facility

a. For Destination Confirm mailings only, the mailer assigns a unique Shipment ID number to each shipment and affixes an associated Shipment ID barcode on proper documentation forms (PS Form 8125, *Plant-Verified Drop Shipment (PVDS) Verification and Clearance,* or PS Form 3152-A, *Confirm Advanced Shipping Notice (ASN) Shipment ID*) that accompany the mail as it is inducted.

b. The mailer drops the shipments at the Postal Service facility.

c. When the mailer drops a shipment at the Postal Service facility, the Postal Service receiving employee follows proper procedures for taking possession of the mail.

d. Upon induction, the Postal Service receiving employee scans the Shipment ID barcode on the PS Form 8125 or PS Form 3152-A to generate an Entry Scan.

e. The Postal Service sends the Entry Scan data to the Confirm subscriber.

Refer to chapter 5 for detailed information.

1-2.4 Mail Processing at a Postal Service Facility

a. The Postal Service processes the mailpieces on mail processing equipment (MPE) and sends scan data to the mailer. Confirm data is generated each time that a "machine-readable" mailpiece, with machine-readable Confirm barcodes, is sorted using automated MPE. Mailpieces that are not processed on MPE do not generate Confirm mailpiece scan data. Mailpiece scan data contains processing location, sort operation, date/time, and barcode digits.

b. The Postal Service continues to process the mailpieces on MPE in preparation for delivery.

Refer to chapter 6 for detailed information.

1-2.5 Data Access and Interpretation

a. The mailer receives entry scan and mailpiece scan data from the Postal Service. Options are either to receive data electronically via scheduled file transfer, or to download the data from the Mail Tracking and Reporting Web site at *http://mailtracking.usps.com*. Entry scan notifications can also be received via e-mail.

b. The mailer integrates and utilizes Confirm data to suit their business needs. The mailer references support resources (e.g., Operation Code listing) to help interpret the data and turn it into useful information. In most cases, data can indicate mail delivery dates with a high level of certainty.

Refer to chapter 7 for detailed information.

1-3 Applications and Potential Benefits

Confirm service provides mailers with valuable mail intelligence data that allows them to make appropriate and timely decisions.

1-3.1 Organizations

Organizations that may benefit from Confirm service include the following:

a. Advertising agencies.

b. Audio and book clubs.

c. Banks.

d. Catalog and mail order companies.

e. Collection agencies.

f. Direct mail advertisers.

g. Financial organizations.

h. Government agencies.

i. Insurance companies.

j. Mail service providers.

k. Non-profit organizations/charities.

l. Political organizations.

m. Printing and publishing companies.

n. Restaurant and hospitality companies.

o. Retailers.

p. Telecommunications companies.

q. Utility companies.

1-3.2 Potential Benefits

Potential benefits from Confirm service may include the following:

a. Collections and dunning optimization.

b. Estimated cash flows for improved cash management.

c. Improved customer service and retention.

d. Improved remittance center processing performance.

e. Improved integration of marketing efforts to increase response rates and reduce costs.

f. Increased return on investment (ROI) on marketing and advertising expenditures.

g. Reduced unnecessary outbound customer contact calls.

h. Optimized work force staffing.

1-3.2.1 Improving Messaging

a. *Heighten awareness.* Identify mail delivery trends that will help set mailing schedules using in-home delivery dates from Destination Confirm service on outgoing mailings.

b. *Integrate direct marketing programs.* Boost response rates by timing follow-up e-mail or telemarketing calls to coincide with in-home direct mail delivery by taking advantage of the delivery predictability that comes with using Confirm service to track outgoing mailings.

c. *Sharpen follow-up communications.* Use the mail intelligence gathered from Confirm service to track incoming and outgoing mailings to improve the effectiveness of telemarketing follow-up.

d. *Ensure timely delivery of marketing messages.* Ensure that marketing messages reach target audiences in time to support promotions and boost traffic by using Confirm service data for near real-time tracking of outgoing solicitations.

e. *Test different offers.* Test different creative images and offers against others to evaluate the success of ad campaigns and determine which bring higher response rates by using Confirm service on both incoming and outgoing mailpieces. Confirm results are faster than conventional seeding methods for which results may take weeks or months to compile.

f.   *Evaluate mail effectiveness.* Plan future campaigns by using Confirm service on incoming reply mail to measure how effective direct mail is at generating responses or sales and identify the day of the week customers are putting reply mail into the mailstream. Confirm data can be used to identify and analyze response rate curves.

1-3.2.2 Improving Operations and Reducing Costs

a.   *Improve and determine cash flow.* Track accounts receivable incoming mailpieces to estimate daily cash flow by knowing in advance who is returning payments.

b.   *Improve lockbox operations.* Ensure the optimal resources for processing checks based on the incoming check volume identified by Origin Confirm service on incoming mailpieces.

c.   *Encourage timely responses.* Monitor delivery patterns from outgoing Confirm mailings to ensure that time-sensitive offers are delivered to customers before respond-by dates. Know when customers are about to receive bills, credit cards, insurance cancellations, notices, direct mail solicitations, and other important mail.

d.   *Reduce collection cost and customer frustration associated with dunning notices.* Save money and reduce customer frustration by using Confirm service on incoming payments to determine the appropriate follow-up. Know that the check really is in the mail!

e.   *Grant or deny customer reprieves.* Use Confirm scan data on outgoing and incoming mailpieces to know whether customers are receiving their bills in time to submit payments by designated due dates. This is valuable information to have when considering the issuance of reprieves on late payments.

f.   *Mail intelligently.* Determine mailing priority on outgoing mailpieces by using Confirm data to identify customer payment and response patterns.

g.   *Improve management of call centers.* Use Confirm service on outgoing mailpieces to anticipate call volumes.

h.   *Improve management of inventory.* Stock inventory based on Confirm scan data reported on outgoing mail and/or incoming reply mail.

i.   *Monitor and manage supply chain vendors.* Use Destination Confirm entry scan data to know when vendors induct mailpieces for your customers.

j.   *Reduce credit card and check fraud.* Track where new credit cards and checks are in the mailstream and predict delivery using Confirm service on outgoing mailings.

k.   *Process orders efficiently.* Respond to orders immediately by using Confirm service on incoming mailpieces that indicate an order by mail. Also use Confirm service on outgoing mailpieces to know when customers receive fulfillments of mail orders.

l. *Document mailings.* Have documentation that mail was sent and that the Postal Service has begun processing mailpieces with Destination Confirm service on outgoing mailings and/or Origin Confirm service on incoming mailings. Using Confirm service to track mailpieces improves customer relationship management.

m. *Promote customer satisfaction.* Enable call centers to better manage customer relationships by using Confirm data on incoming and outgoing mail to lead appropriate communication.

n. *Identify target customers.* Cross reference response rate patterns and demographic data to target potential customers and develop customer acquisition strategies using Origin Confirm service on incoming mailings.

o. *Customer acquisition.* Improve response rates of new customers by using Confirm service on outgoing solicitations and messages to synchronize timely message delivery to marketing e-mails and/or telemarketing messages.

p. *Strengthen customer loyalty.* Use Confirm barcodes on your outgoing mailpieces to bring delivery predictability that customers can trust. Customers grow loyal to companies that are dependable.

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2 Subscribing to Confirm

Confirm is a subscription-based service. Before mailing Confirm mail with the proper Confirm barcodes, the mailer must become a Confirm subscriber. To become a subscriber, the mailer must submit a completed application form, subscription fee payment, and verification of the mailer and/or printing vendor's ability to generate accurate and scan-ready barcodes prior to mailing.

2-1 Subscription Rates

Confirm service offers three subscription levels: Silver, Gold, and Platinum. All subscription levels offer both Destination and Origin Confirm services. See Exhibit 2-1 for subscription fees effective May 12, 2008.

Exhibit 2-1
Confirm Subscription Fee Structure[1] Effective May 12, 2008

Level	Price	Period	Number of Subscriber IDs[2]	Number of Mailpiece Scans With Subscription	Cost for Additional Scans During Subscription Period	Upgradeable?
Silver	$2,000	3 months	1	15 million	$500 per 2 million scans	No
Gold	$6,500	1 year	1	50 million	$800 per 6 million scans	Yes
Platinum	$23,500	1 year	3	Unlimited	Not applicable	Not applicable

1. The Confirm fee structure and fees are subject to change based on standard Postal Service rate adjustment procedures.
2. A mailer can purchase additional Subscriber IDs as follows:
   $2,500 for 1 year (Gold and Platinum), or $900 for 3 months or end of subscription period, whichever comes first.

For asistance with subscribing or renewing a Confirm subscription, contact Confirm Customer Assistance at *confirm@usps.gov* or at 800-238-3150.

2-2   Applying for Confirm Service

From the time the Postal Service receives a completed application from the mailer, it can take as little as 2 weeks to process the application and activate a Confirm subscription. You may also go to *http://mailtracking.usps.com*.

To apply for Confirm service, follow these steps:

1. Obtain the Confirm service application form by visiting the Postal Service's Mail Tracking and Reporting (MT&R) Web site at *http://mailtracking.usps.com;* click on *Confirm* and then on *Confirm Resources.* Or call Confirm Customer Assistance at 800-238-3150.

2. Complete and submit the Confirm Service application form per instructions.

3. Receive verification from Confirm Customer Assistance that your Confirm application was received and completed properly. Then go to the MT&R Web site at *http://mailtracking.usps.com* to complete the Postal Service Customer Registration process by clicking on the "Sign Up" button for "New Users." Registration at this site provides you with access to the Confirm Service links. Customer Assistance will review the information and notify you of your MT&R Web site logon.

4. Receive Confirm Subscriber ID(s) from Confirm Customer Assistance.

5. Submit 30 sample mailpieces barcoded with proper Confirm barcodes. Also submit 30 sample Shipment ID barcodes. Refer to chapters 3 and 5 for guidelines on preparing Confirm mail and induction forms containing the Shipment ID barcode. Mailers choosing the Intelligent Mail barcode format should refer to 3-5 for details on obtaining information about barcode software.

6. Receive verification from the Postal Service as to whether or not your sample mailpieces and Shipment ID barcodes are compliant with Postal Service specifications. If necessary, modify your sample mailpieces and Shipment ID barcodes based on the guidance provided by the Postal Service.

7. After receiving the Confirm subscription invoice from the Postal Service, contact Confirm Customer Assistance for directions to pay via automated clearinghouse (ACH) or submit payment to:

    USPS DISBURSING OFFICER
    ACCOUNTING SERVICE CENTER
    2825 LONE OAK PKWY
    EAGAN MN 55121-9640

8. Receive final approval from the Postal Service after receipt of payment.

9. Receive username/password and confirmation of Confirm subscription activation.

Call Confirm Customer Assistance at 800-238-3150 with questions or concerns regarding the application process or preparing Confirm mailings.